

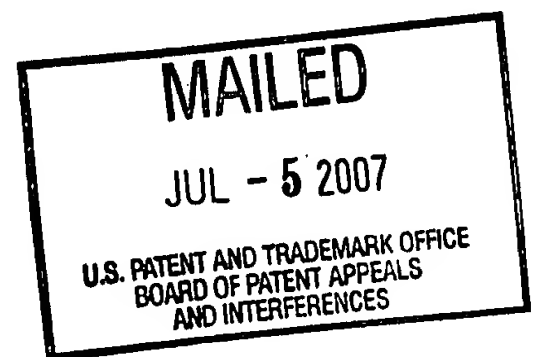
1 RECORD OF ORAL HEARING  
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3 UNITED STATES PATENT AND TRADEMARK OFFICE  
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5  
6 BEFORE THE BOARD OF PATENT APPEALS  
7 AND INTERFERENCES  
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10 Ex parte CHRISTINE DUPUIS  
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13 Appeal 2007-1160  
14 Application 09/663,183  
15 Technology Center 1600  
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18 Oral Hearing Held: May 17, 2007  
19  
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21  
22 Before TONI R. SCHEINER, DONALD E. ADAMS, and RICHARD M.  
23 LEBOVITZ, Administrative Patent Judges  
24  
25

26 ON BEHALF OF THE APPELLANT:

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34 ALSO PRESENT:

35 COURTNEY MEAGER  
36

1       The above-entitled matter came on for hearing on Thursday, May 17,  
2       2007, commencing at 10:39 a.m., at the U.S. Patent and Trademark Office,  
3       600 Dulany Street, Alexandria, Virginia, before Lanieda D. Briggs, CSR No.  
4       10571, Notary Public.

5  
6               THE CLERK: Calendar number 35, Mrs. Herzfeld.

7               MS. HERZFELD: Good morning.

8               JUDGE SCHEINER: We have something new now. We are  
9       having a court reporter. Do you have a card to give her? Or could you just  
10      spell your name for the record. We're all getting used to this.

11              MS. HERZFELD: I wasn't expecting it. I knew that it was  
12      coming. I wasn't expecting one because this has never been published.

13              JUDGE SCHEINER: It's still going to be part of the record.

14              MS. HERZFELD: I'd be happy to spell it. It's Deborah, D-E-  
15      B-O-R-A-H, Herzfeld, H-E-R-Z-F-E-L-D.

16              JUDGE SCHEINER: If, during the course of your discussion,  
17      if there are some terms that may be difficult, that have difficult spellings,  
18      you might want to spell those into the record, too. I'll try to remember.

19              MS. HERZFELD: Yes. From experience, if you can think of  
20      it, please ask if you are not sure of what the spelling of it is, so hopefully I  
21      don't need the files. I won't pull them out unless we get to that point.

22              JUDGE SCHEINER: Whenever you are ready, let's get started.

23              Oh, I'm sorry. One more thing. Would you like to introduce  
24      your guest.

1 MS. HERZFELD: This is my colleague, Courtney Meager.  
2 She's here to observe her first viewing of an oral argument, so hopefully I'll  
3 impress her. I'm sure you all will. Okay.

4 Good morning. My name is Deborah Herzfeld, representing the  
5 appellant. And I will go ahead and start right off the bat, as I assume people  
6 are today, saying that even in view of the Supreme Court ruling in KRS, the  
7 appellant believes that the examiner has not established a prime facie case of  
8 obviousness.

9 First of all, KSR did not overturn the teaching suggestion for a  
10 motivation test. The Supreme Court noted the requirement of demonstrating  
11 a teaching suggestion or motivation, or to make it easier, a TSM, to combine  
12 known elements in order to show that the combination of obviousness  
13 provides a helpful insight. This is at KSR, opinion slip 14.

14 Further, in KSR, the Supreme Court, to facilitate this analysis  
15 of whether there was an apparent reason to combine the known elements in  
16 the fashion claimed by the patent at issue, should be made explicit. This is  
17 also at 14.

18 And the Supreme Court cites in re: Conn (phonetic), a Federal  
19 Circuit 2006 case which states that, "Rejections on obviousness grounds  
20 cannot be sustained by mere conclusory statements. Instead, there must be  
21 some articulated reasoning with a rational underpinning to support the legal  
22 conclusion of obviousness."

23 Second, the TSM test can also help avoid hindsight.

24 The Supreme Court noted, "It is important to identify a reason  
25 that would have prompted a person of ordinary skill in the relevant field to  
26 combine the elements in a way that the new claimed invention does, because

1 inventions in most, if not all, instances rely upon building blocks long since  
2 uncovered and claimed discoveries almost of necessity will be combinations  
3 of what in some sense is already known."

4 This is in the slip opinion at 15.

5 Third, KSR does not -- held that the TSM test does not  
6 contradict Graham and says there is no necessary inconsistency between the  
7 idea underlying the TSM test and the Graham analysis. That's KSR, also at  
8 15.

9 And finally, the PTO examination standard has not changed.

10 Following the KSR decision, the PTO issued a memorandum to  
11 the Technology Center on May 3rd, 2007, indicating that, "In formulating a  
12 rejection under 35 U.S.C. 103, section A, based upon a combination of prior  
13 elements, it remains necessary to identify the reason why a person of  
14 ordinary skill in the art would have combined the prior art elements in the  
15 manner claimed."

16 Thus, the main crux of appellant's argument is still -- should  
17 still be considered good law and that the examiner has not established a  
18 prime facie case of obviousness.

19 As you may recall, the claims relate to a cosmetic composition  
20 comprising at least one specific silicone acrylate copolymer and at least one  
21 non-ionic polymer comprising at least one vinyl lactam unit chosen from  
22 specific ter-polymer (phonetic).

23 The claims also relate to holding a hairstyle, a process for  
24 making a cosmetic product for the hair, skin, nails, lips, eyebrows or  
25 eyelashes. These compositions are useful in styling without causing a

1 powdering effect where the product dries and becomes crispy and falls off.  
2 It's very unattractive and undesired by the public consumers.

3 So the examiner cites Furstenberg (phonetic) and Blankenburg  
4 (phonetic). The examiner contends that Blankenburg teaches a hairstyling  
5 product where they water the vinyl lactam polymer comprising ethylenically  
6 unsaturated monomers, E-T-H-Y-L-E-N-I-C-A-L-L-Y.

7 JUDGE LEBOVITZ: Okay. So since you got right to the  
8 middle of KSR, we've got Blankenburg teaching one of the copolymers, we  
9 have Firstenberg teaching the vinyl lactam, then the examiner says, Well,  
10 look, Firstenberg says that you can make a hairstyling composition which  
11 comprises at least one film polymer, so therefore, that's motivation to put  
12 two of them together.

13 So there is that reason for putting the vinyl lactam together and  
14 the silicone acrylate polymer together. So why is that not reason enough  
15 under KSR.

16 MS. HERZFELD: Well, basically under KSR, the examiner is  
17 saying combination for the sake of combining. The examiner hasn't actually  
18 pointed to a reason that would prompt.

19 I mean, using the KSR language, a reason that would prompt  
20 which is essentially the same as a motivating factor to combine them looking  
21 at Firstenberg, even though he says Firstenberg teaches that you can  
22 combine multiple film forming polymers, there aren't any combinations  
23 shown in Firstenberg.

24 JUDGE LEBOVITZ: Why does it have to be a specific  
25 example? He teaches that generically. We know that we have two things

1 out there that are good for hair, supposedly. Why is that enough to not put  
2 them together?

3 MS. HERZFELD: Well, secondly, I would say that  
4 Blankenburg teaches away from vinyl lactam polymers.

5 This was also in our brief, that Blankenburg states in its  
6 beginning discussions discussing its polymers, that vinyl lactam  
7 homopolymers and copolymers were preferred.

8 But subsequently, polymers containing carboxylate groups have  
9 become increasingly more important, and we believe this statement leads  
10 into Blankenburg's discussion of what is wrong with the art, and they are  
11 teaching of how their invention is an improvement on what's already out  
12 there.

13 JUDGE LEBOVITZ: As the examiner pointed out,  
14 Blankenburg doesn't point out any problem with the vinyl lactam polymer.

15 MS. HERZFELD: You don't need to be teaching a problem to  
16 be considered teaching away.

17 JUDGE LEBOVITZ: Normally a skilled worker improves,  
18 right? That's why we're here. We're always trying to make it better and  
19 newer products. That doesn't mean there is something wrong with the old  
20 product that you are not going to use it.

21 It's just, Look, we have another one, and given Firstenberg  
22 saying, Hey, you can put more than two together, more than one together,  
23 why not say, Well, use this one, which was fine, and this newer one and put  
24 them together, and we'd expect the predictable result of getting something  
25 that would make your hair more soft or manageable, whatever the assertions  
26 were.

1 MS. HERZFELD: I understand what you are saying. I have a  
2 couple of points to address that. The first would be that even under KSR the  
3 standard cannot be satisfied merely by saying someone is not going to be  
4 discouraged to put these two together.

5 But, you know, really there needs to be a reason prompting it,  
6 and Blankenburg is teaching that, you know, these were the needs and now  
7 they are not. We want something different from that. Why would you then  
8 go back and try to put something in it?

9 JUDGE LEOVITZ: "Reason prompting" sounds exactly like  
10 what KSR was rebelling against. "Reason prompting" sounds to me sort of  
11 like explicit suggestion, and KSR said ordinarily skilled workers is not an  
12 automaton. He's a person of ordinary creativity, whatever the line was.

13 MS. HERZFELD: Right. No, but in KSR at page 15, "It can  
14 be important to identify a reason that would have prompted a person of  
15 ordinary skills in the relevant field to combine the elements in the way the  
16 claimed new invention does, because inventions in most, if not all, instances,  
17 we rely on building blocks long since uncovered." This is the way to  
18 caution against hindsight.

19 In a broader picture, you know, both Graham and KSR  
20 emphasize the fact that the validity of these claims come down to the facts,  
21 and KSR even says on, starting on page 13, "Following these principles may  
22 be more difficult in other cases than here because the facts are necessarily  
23 going to be different."

24 If you take a step back and look at the Supreme Court holdings  
25 in Hotchkiss, Graham, it's a companion case of Kelmar v. Cook, KSR, these  
26 are all mechanical cases.

1           These are all cases where if you pull a lever, you see what  
2 string is moving, you can understand how these elements are going to work,  
3 but when you get to chemical cases, it's not that easy. As anyone who spent  
4 time in the lab has known or the stereotypical picture of a kid in a lab who  
5 blows things up by adding something together.

6           JUDGE LEBOVITZ: You haven't made any argument about  
7 unpredictability of putting two film formers together and improving hair.  
8 That's not on the record.

9           MS. HERZFELD: No, but what I'm saying is that you can't --  
10 just because these two things work for their stated purpose cannot in and of  
11 itself be the motivation or make it obvious to combine them.

12           If that is your standard, every cosmetic composition becomes  
13 obvious, and that is simply not the way. That in chemistry you are not sure  
14 once you put things together how they are going to react, there's sort of an  
15 underlying uncertainty that's involved. You are not sure how you'll like the  
16 texture or smell or how the fit will work once it's together.

17           Just to give a basic analogy --

18           JUDGE LEBOVITZ: What is predictable about this situation  
19 here?

20           MS. HERZFELD: Just to give a basic analogy, if you have  
21 beer and scotch, both beverages, why would you combine them? That is  
22 what --

23           JUDGE LEBOVITZ: What about aspirin and Advil and  
24 Ibuprofen? Some people take all three at the same time.

25           MS. HERZFELD: There you have it. You know, the examiner  
26 is saying, Here is a styling composition and here is a styling composition.



1 Of course you add them together. Except, why would you add beer and  
2 scotch? You would ruin the scotch. Right?

3 JUDGE LEBOVITZ: Firstenberg says you can put one, at least  
4 one. To me, that adds, you know, it's sort of like saying, in your analogy,  
5 you open up a book, you can combine different alcohols together.

6 MS. HERZFELD: Right. Then again, it's sort of an invitation.  
7 It's a license to go fishing. It's not teaching any combination. It's not  
8 showing that they work. It's saying oh, at least one. You could do this. I'm  
9 not showing you any of that work. It would almost be --

10 JUDGE LEBOVITZ: Obvious to try.

11 MS. HERZFELD: Yeah, it's like you are looking at -- it would  
12 be almost like saying, Well, the cosmetic dictionary teaches all of these  
13 things. Why not put them together?

14 JUDGE LEBOVITZ: Didn't it almost try to say --

15 MS. HERZFELD: It did, but KSR was also talking about a  
16 mechanical case where people were moving towards having an electronic  
17 sensor, and the issue was, where are we going to put this sensor that it won't  
18 get dirty, so we won't put it on the foot pad, but we still need it to interact  
19 with the pedals.

20 I mean, it goes back to that lever string issue. We know this  
21 module can go anywhere, so why don't we put it here?

22 JUDGE LEBOVITZ: KSR also emphasizes the market  
23 pressure, the market demand.

24 I mean, seems to me if you look around, there is big demand to  
25 improve hair, so there would be this big demand to go out there and say,  
26 Look, we're trying to get something that makes hair soft and shiny or

1 whatever these things do, if possible, and we have a limited universe of  
2 things out there, so why not take one that's pretty conventional and take this  
3 other which -- and put it together?

4 MS. HERZFELD: Again, I would say that under that standard  
5 every cosmetic composition becomes obvious. That would be my first  
6 response if you are going to take the market pressure test. Second, the KSR  
7 --

8 JUDGE SCHEINER: Not necessarily, because you still have  
9 secondary considerations. Suppose that those combinations produce an  
10 unpredictable or unsuspected response or result?

11 I think that's what KSR was getting at that when you have two  
12 things that do essentially the same thing, you should look carefully at  
13 combining them when the result is predictable. In this case we don't have an  
14 allegation of unexpected results, do we?

15 MS. HERZFELD: No, but -- no, we do not. We also don't  
16 have any secondary factors to show you because the -- you know, we're still  
17 working on -- when you are prosecuting, it's much harder to have those  
18 results. When you are litigating, you have years of evidence to show. So  
19 then that puts people prosecuting patents at a severe disadvantage if that's  
20 what we're always going to be looking to.

21 JUDGE ADAMS: So the only argument you have is that  
22 Blankenburg teaches away from the combination; is that right?

23 MS. HERZFELD: Correct. Well, not the only. I mean -- but  
24 that is a main one, and that actually leads into my second point, which is that  
25 KSR held that one way a patent subject matter can be proved obvious is by  
26 noting there existed at the time of the invention a known problem.

1 JUDGE ADAMS: Let me stop you there. Your argument  
2 about KSR, it is mechanical, and your case is mechanical. Let's talk about  
3 the chemistry. I think what I'm hearing is it does or doesn't apply because  
4 it's mechanical. Let's look at your mechanical case. Your main argument is  
5 the reference teaches away. Why does the reference teach away?

6 MS. HERZFELD: It teaches that there are drawbacks to these  
7 polymers and that's why it went out and created the polymers it has. So if  
8 Blankenburg created his invention in part to solve the problem that he saw in  
9 these polymers, why, where is the motivation to then add these polymers to  
10 his invention?

11 JUDGE ADAMS: What was the problem that Blankenburg  
12 saw with these particular compounds? Point me to that section.

13 MS. HERZFELD: I wasn't sure. I looked on Pair (phonetic) to  
14 see what translation came with our brief. No translation was on Pair, and  
15 even though it said it was attached, did you get a translation for  
16 Blankenburg?

17 JUDGE LEBOVITZ: Yes, but was there another related case  
18 too it had on appeal?

19 MS. HERZFELD: Yes, but we haven't heard anything on that  
20 case.

21 JUDGE LEBOVITZ: I think it mentioned it in the appendix. It  
22 hasn't been heard yet.

23 MS. HERZFELD: Okay.

24 JUDGE SCHEINER: Do you know offhand if there was a  
25 request for a hearing?

1 MS. HERZFELD: We filed our request for an oral hearing. I  
2 was surprised that both weren't called together.

3 JUDGE SCHEINER: In the future if you notice something like  
4 that, you could mention it.

5 JUDGE LEBOVITZ: If you call them.

6 MS. HERZFELD: Okay. We had originally gotten a notice  
7 that the oral hearing was in 2010, and then a phone call saying that they  
8 really meant this year, so we were wrapped up in that. Okay. Next time.

9 Just in the first page of the translation, does your translation  
10 look like this? Can I approach?

11 JUDGE SCHEINER: Yes, please.

12 MS. HERZFELD: This is what was on the record that we had  
13 submitted a verified translation. Does it look like this?

14 JUDGE LEBOVITZ: We have the translation.

15 MS. HERZFELD: There are two translations in the found --  
16 that I found. I'm trying to figure out which one you have.

17 JUDGE SCHEINER: It doesn't look like --

18 JUDGE ADAMS: We have a PTO translation.

19 MS. HERZFELD: Those are for you. Yeah, that's fine. It  
20 shouldn't really, but in terms of --

21 JUDGE SCHEINER: Do you need this to --

22 MS. HERZFELD: No, I have one.

23 JUDGE LEBOVITZ: Well, wait a minute.

24 MS. HERZFELD: I'm sorry?

25 JUDGE ADAMS: I think we can get past all of this. If we  
26 hand these back to you, this will just be for the purposes of this discussion.

1 MS. HERZFELD: That's fine. Like, just, for example, the  
2 second paragraph.

3 JUDGE ADAMS: On page 2; is that right?

4 MS. HERZFELD: Yes, where it says, The requirements  
5 mentioned above are met today by various types of polymers, but the feel of  
6 the hairstyle is using these polymers often perceived as unpleasant or dull or  
7 unnatural, and how there is attempts to improve these polymers and the  
8 formulations containing them to make them sort of cosmetically and  
9 commercially viable.

10 JUDGE ADAMS: Well, it says that these types of  
11 compositions have been used for 50 years, right? And now, yeah, we always  
12 -- that's what Judge Lebovitz said, we're always wanting to improve. Let's  
13 improve upon these particular polymers; is that right? Is that a good read of  
14 that paragraph?

15 MS. HERZFELD: Yeah, always. They are always seeking  
16 improvement.

17 JUDGE ADAMS: What is it below this reference that teaches  
18 away from its combination with the secondary reference other than we are  
19 always seeking to improve and we're going to improve on these particular  
20 ingredients.

21 MS. HERZFELD: Well, it says, "At first, vinyl lactam  
22 homopolymers and copolymers were preferred" --

23 JUDGE ADAMS: Are we still in that same first paragraph?

24 MS. HERZFELD: Yeah, first paragraph, second sentence.

25 "But subsequently, polymers containing carboxylate groups  
26 have become increasingly important." And teaching away does not need to

1 be a slamming of the prior art. It can be just anything that would discourage  
2 you from using it. And what this is saying, Yeah, we used X, yeah, we used  
3 Y. We didn't find any of them satisfactory. We came up with Z.

4 JUDGE ADAMS: Nowhere does it say anything about being  
5 satisfactory or not.

6 MS. HERZFELD: Second paragraph, where they talk about  
7 these known polymers and how --

8 JUDGE ADAMS: You mean the second sentence?

9 MS. HERZFELD: Sorry?

10 JUDGE ADAMS: The second sentence of the first paragraph?  
11 Isn't that where you directed me to?

12 MS. HERZFELD: Yes, where they said that, "Vinyl lactam  
13 homopolymers and copolymers were preferred but subsequently" --

14 JUDGE ADAMS: These other reagents were more important.

15 MS. HERZFELD: Became increasingly more important, but  
16 then the second paragraph is that, "The feel of the hairstyle is that using  
17 these polymers is often perceived as dull and unnatural." First sentence,  
18 second line of the second paragraph.

19 JUDGE ADAMS: Okay.

20 JUDGE LEBOVITZ: But it's not clear what polymers they are  
21 talking about here. That's kind of a general statement of a deficiency in the  
22 prior art. I take that back, not a deficiency, but a general statement about  
23 something that was used in the prior art, but it's not clear to us that they are  
24 talking about the vinyl lactam because they also talk about the carboxyl  
25 there.

1 MS. HERZFELD: I think it's just in context what they are  
2 saying is that these were used. They are not really used anymore and then  
3 they are included in this.

4 JUDGE ADAMS: It doesn't say they are not used anymore.  
5 These compounds have been used for 50 years and we're going to improve  
6 upon them. In our opinion, they leave this unpleasant feeling in your hair, so  
7 we're going to improve upon that a little more.

8 MS. HERZFELD: That's another way of interpreting it, yeah.

9 JUDGE ADAMS: So what is it specifically other than this stuff  
10 we can interpret all these different ways? What is it exactly in this reference  
11 that is a teaching away, that's not even open for interpretation?

12 MS. HERZFELD: I'm submitting the first paragraph.

13 JUDGE ADAMS: All right.

14 JUDGE LEBOVITZ: But on the other hand, if you look at  
15 Firstenberg, Firstenberg seems to think that they've got a pretty good  
16 polymer, right?

17 MS. HERZFELD: It's the polymer that helps Firstenberg meet  
18 the mechanical properties it is trying to meet. Firstenberg really teaches how  
19 to get a certain amount of product out of a spray. That's what it's teaching.  
20 It just happens it just likes those polymers getting out of a spray. So it  
21 doesn't really testify that you could or would or might want to use them in  
22 other forms.

23 JUDGE ADAMS: Your main argument is this teaching away.  
24 Your argument is that teaching away is taught by Blankenburg on the first  
25 page, first two paragraphs. What else do you have?

1 MS. HERZFELD: And the fact that teaching suggestion  
2 motivation is still alive.

3 JUDGE ADAMS: We'll consider KSR in part of our  
4 deliberation but other than KSR --

5 MS. HERZFELD: Well, I would also submit that the  
6 examiner's application of Kerkoven (phonetic) is wrong. It gets back to  
7 basically what we were discussing earlier, that Kerkoven is a detergent, plus  
8 a detergent, makes a detergent.

9 The examiner is trying to make Kerkoven say a compound plus  
10 a compound, making a composition for hairstyling is obvious. And as we  
11 were saying earlier --

12 JUDGE ADAMS: You haven't limited Kerkoven to its  
13 expressed facts?

14 MS. HERZFELD: Yes.

15 JUDGE ADAMS: I don't think that's accurate, but I understand  
16 your argument.

17 MS. HERZFELD: The argument that the examiner puts forth  
18 here is used all of the time by the examiners that they really want to broaden  
19 it to say that any known compound plus any known compound is a known  
20 and obvious entity.

21 And the examiner, again, I would say is basically saying  
22 because their own compositions for hairstyling, it's obvious to add them  
23 together, and I don't think that that can be an accurate standard.

24 I think that would basically eviscerate all cosmetic  
25 compositions, most cosmetic compositions. Most compositions, which as



1 the Supreme Court pointed out, most of these inventions necessarily are  
2 known building blocks put together in different ways.

3 In chemistry it's not always -- you can't -- you won't always  
4 know that something will work. I realize we didn't say unexpected results in  
5 our argument, but I think that that's just an underlying factor in chemistry is  
6 that you don't know what's going to happen when you combine two things  
7 together.

8 Let me just make sure --

9 JUDGE LEBOVITZ: I hear that argument, but I don't see any  
10 evidence that it's, you know, there is any unpredictability in combining this.  
11 Of which there may be, but I didn't see that you made that argument in your  
12 brief.

13 MS. HERZFELD: We did not submit testing.

14 I think I've made my main points. I know you guys are running  
15 over, so in summary I would say --

16 JUDGE SCHEINER: Thank you for coming. Thank you for  
17 addressing KSR, because we were going to bring that up.

18 MS. HERZFELD: There is no way you couldn't address it.  
19 So...

20 JUDGE SCHEINER: This does seem to be consistent with  
21 what we have.

22 MS. HERZFELD: Great.

23 JUDGE SCHEINER: At least those first couple.

24 JUDGE LEBOVITZ: Do you know which one the examiner  
25 relied on?

1 MS. HERZFELD: Probably the patent office one. I know we  
2 submitted this to him.

3 JUDGE LEBOVITZ: Do you have a problem with us relying  
4 on the PTO one?

5 MS. HERZFELD: I don't think -- I don't think so, but I don't  
6 know. I'd have to go back.

7 JUDGE SCHEINER: We don't have the complete file here.

8 MS. HERZFELD: That's why I'm upset that we submitted it  
9 with the brief, but it's not on Pair, so I can't see which one got submitted  
10 with the brief. If you look, it says, Attachment translation of --

11 JUDGE LEBOVITZ: But if you submitted it with the brief,  
12 then it's okay.

13 MS. HERZFELD: So it should have been -- I thought it would  
14 have been scanned with the brief onto Pair, but it wasn't.

15 JUDGE SCHEINER: Okay. It might be on -- our working file  
16 is taken from the official file, but it's not the complete file so we'll --

17 MS. HERZFELD: I mean, one of the things that may be like  
18 the tenses of the verbs might be off and the adjectives might be different.

19 (Whereupon, the proceedings at 11:08 a.m. were concluded.)